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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 847,892	05 02 2001	Joseph F. Walsh	35006-00019CIP	7516

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SUMMIT LAW GROUP
1505 Westlake Ave., North
Seattle, WA 98019

EXAMINER

LE. THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 02 28 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,892

Applicant(s)

BOYDSTON ET AL.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO 152)
- 6) ☐ Other _____

DETAILED ACTION

The formal drawings filed on 12/31/2001 have been received. Claims 1-86 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Knowles et al. (hereinafter Knowles – 5,869,819) or under 102(b) by Wellner (5,640,193).

Knowles discloses a hand-held optical reader comprising a keypad, a scanning module for reading URL encoded bar codes. The system includes the step of decoding the bar codes, retrieving data relating to the URLs through a network and outputting the

retrieved information to a computer. Similarly, Wellner discloses a handheld terminal for reading the retrieving information through a subscriber's network. Wellner also discloses the use of URL encoded bar code. As can be seen, Knowles and Wellner disclose the claimed invention.

Claims 2-6, 19, 20, 22-24, 26-27, 30-33, 35, 58-60, 64-68, 73, 75-77, 79-83, 85-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Knowles et al. (hereinafter Knowles – 5,869,819).

Regarding claims 2-4, see the discussions regarding claim 1. Knowles shows a bar code scanner having a keyboard.

Regarding claim 5-6, Knowles discloses the use of URL encoded bar code which would meet all limitations set forth in these claims.

As to claims 19, 20, 22-24, 26-27, 30-33, 35, 58-60, 64-68, 73, 75-77, 79-83, and 85-86, see the discussions set forth above. Specifically, Knowles discloses a handheld laser scanner comprising CCD array, the serial input/output ports, etc. as recited in the claims.

Claims 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wellner (5,640,193).

Wellner discloses a system for downloading programs from a subscriber network which includes the use of an access code.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-18, 21, 25, 28-29, 34, 36-57, 61-63, 69-72, 74, 78, and 84, are rejected under 35 U.S.C. 103(a) as being obvious by Knowles et al. (hereinafter Knowles – 5,869,819).

Regarding claims 8-18, 21, 25, 28-29, 34, 36-57, 61-63, 69-72, 74, 78, and 84, the system as taught by Knowles has been discussed above. The claims differ in calling for various variations and combinations including: memory, card reader, low-power proximity detector, magnetic card, audio input/output ports, etc. It would have

been obvious to incorporate these features in the system as taught by Knowles. The use of each and some combinations of these features in bar code scanning system are known and have been incorporated in commercially available scanners. For example, the use of proximity detector has long been used and developed by many scanner manufacturers, including: Symbol Technologies; Spectra Physics Corp.; Norand; Metrologics; etc. Further, magnetic card reader and audio input/output ports have been incorporated in self-checkout and POS environments. Without any unexpected result, the modifications are merely considerations which are well within skill levels and expectations of an ordinary skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-350. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Le, Thien M.
Primary Examiner
Art Unit 2876
February 14, 2002